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In re Application of
Chomenky et al.
Application No. 09/931672 : DECISION ON PETITION
Filing or 371(c) Date: 08/17/2001 : UNDER 37 CFR 1.78(a)(6)
Title of Invention: APPARATUS AND
METHOD FOR REDUCING
SUBCUTANEOUS FAT DEPOSITS,
VIRTUAL FACE LIFT AND BODY
SCULPTURING BY ELECTROPORATION

This is a decision on the Petition Under 37 C.F.R. § 1.78(a)(6) to Accept Unintentionally Delayed Claim for Benefit Under 35 U.S.C. 119(e)," filed September 23, 2008, to accept an unintentionally delayed claim under 35 U.S.C. § 119(e) for the benefit of priority to a prior-filed provisional application.

The petition is **DISMISSED**.

A petition under 37 CFR 1.78(a)(6) is only applicable to those applications filed on or after November 29, 2000. Further, the petition is appropriate only after expiration of the period specified in 37 CFR 1.78(a)(5)(ii) and must be filed during the pendency of the nonprovisional application. In addition, the petition must be accompanied by:

- (1) the reference required by 35 U.S.C. § 119(e) and 37 CFR 1.78(a)(5)(i) to the prior-filed application, unless previously submitted;
- (2) the surcharge set forth in § 1.17(t); and
- (3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(5)(ii) and the date the claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional.

This petition fails to satisfy item (1) above. In this regard, 37 CR 1.78(a)(5)(ii) requires that a claim for benefit of priority to a prior-filed provisional application must be submitted during the pendency of the application. Further to this, the MPEP 201.11(E) provides: If the later-filed application is a utility or plant application filed on or after November 29, 2000, the reference to the prior-filed application must be submitted within the time period set forth in 37 CFR 1.78(a) (e.g., during

the pendency of the later-filed application and within the later of 4 months from the actual filing date of the later-filed application or 16 months from the filing date of the prior-filed application) for a benefit claim under 35 U.S.C. 120, 121, or 365(c), and also for benefit claim under 35 U.S.C. 119(e). (Emphasis supplied).

As such, a Certificate of Correction is not a valid mechanism for adding or correcting a priority claim under 35 U.S.C. § 119(e) after a patent has been granted on an application filed on or after November 29, 2000. *See* MPEP 1481.03.. Therefore, as this application matured into Patent No. 6,697,670 on February 24, 2004, a claim for benefit of priority to the above-noted provisional application cannot now be added by way of a Certificate of Correction.

Applicant may attempt to add the benefit claim by way of reissue. The MPEP 1481.03 provides:

Where the application, which became the patent to be reissued, was filed on or after November 29, 2000, reissue may be employed to correct an applicant's mistake by adding or correcting a benefit claim under 35 U.S.C. 119(e). A petition under 37 CFR 1.78(a)(6) for an unintentionally delayed claim under 35 U.S.C. 119(e) would not be required in addition to filing a reissue application.

Section 4503 of the American Inventors Protection Act of 1999 (AIPA) amended 35 U.S.C. 119(e)(1) to state that:

No application shall be entitled to the benefit of an earlier filed provisional application under this subsection unless an amendment containing the specific reference to the earlier filed provisional application is submitted at such time during the pendency of the application as required by the Director. The Director may consider the failure to submit such an amendment within that time period as a waiver of any benefit under this subsection. The Director may establish procedures, including the payment of a surcharge, to accept an unintentionally delayed submission of an amendment under this section *during the pendency of the application*. (Emphasis added.)

The court in Fontijn held that 35 U.S.C. 251 was sufficiently broad to correct a patent where the applicant failed to assert or failed to perfect a claim for foreign priority during the prosecution of the original application even though 35 U.S.C. 119(b) at that time required a claim and a certified copy of the foreign application to be filed before the patent is granted. Similarly, the Office may grant a reissue for adding or correcting a benefit claim under 35 U.S.C.119(e) that requires the benefit claim to a provisional application be submitted during the pendency of the application. (Emphasis supplied).

Further correspondence with respect to this matter should be addressed as follows:

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Any questions concerning this matter may be directed to Derek Woods at (571) 272-3232.



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